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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/896,094 | 06/28/2001 | Masataka Shinoda | 09792909-5049 | 9407 |
| 7590 | 10/22/2004 | | EXAMINER | |
| David R. Metzger SONNENSCHEIN NATH & ROSENTHAL Wacker Drive Station, Sears Tower P.O. Box #061080 Chicago, IL 60606-1080 | | | MCPHERSON, JOHN A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1756 | |
| DATE MAILED: 10/22/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-------------------|-------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/896,094 | SHINODA, MASATAKA |
| | Examiner | Art Unit |
| | John A. McPherson | 1756 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 16 August 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 3,7,11,14,17,19,21,23-33,35,37,39 and 41-94 is/are pending in the application.

4a) Of the above claim(s) 44-93 is/are withdrawn from consideration.

5) Claim(s) 94 is/are allowed.

6) Claim(s) 3,7,11,14,19,21,23-33,35,37,39 and 41-43 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date _____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____. |
|--|---|

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the Amendment filed 8/16/04.

2. The Amendment filed 8/16/04 successfully overcomes the rejections and objection set forth in paragraphs 2, 3 and 5 of the Office Action mailed 3/11/04. Accordingly, these rejections and the objection are withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 25, as amended, presents the limitation that the recording area A has information C, however the specification does include a description of "information C". The introduction of "information C" into claim 25 is viewed as new matter.

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4. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites the limitation "said light transmission substance" in line 2. There is insufficient antecedent basis for this limitation in the claim. This rejection could be overcome by replacing "substance" with --substrate--, which has antecedent basis in claim 3 (also see page 13, line 22 to page 14, line 2 of the specification).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3, 7, 11, 14, 17, 19, 21, 23-33, 35, 37, 39 and 41-43 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,975,355 (US '355) for the reasons of record as set forth in paragraph 4 of the Office Action mailed 3/11/04, and as further discussed below.

Response to Arguments

6. Applicant's arguments filed 8/16/04 have been fully considered but they are not persuasive. With respect to the rejection over US '355, Applicant argues that this reference does not disclose a layer in a recording medium in which information B can

be recorded as a change of refractive index, change of extinction coefficient, change of transmittance or change of reflectance of a protective film or substrate. However, the protective layer and substrate of US '355 comprise the same materials as the protective film and substrate of the recording medium of the present invention (e.g. a polycarbonate substrate, see the abstract of US '355 and page 13, line 22 to page 14, line 2 of the specification). Therefore, they would inherently be capable of recording information as a change of refractive index, change of extinction coefficient, change of transmittance or change of reflectance.

Pertinent Prior Art

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6,168,207 discloses an optical disc comprising a transparent substrate having an information recorded surface, a reflective layer, and adhesive layer, a mask layer, and a dummy substrate, wherein the adhesive layer is made of an adhesive of which curing speed is changed according to a controlled amount of radiation of ultraviolet rays, whereby a watermark can be recorded in the adhesive layer.

Allowable Subject Matter

8. Claim 94 is allowed.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. McPherson whose telephone number is (571) 272-1386. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John A. McPherson
Primary Examiner
Art Unit 1756

JAM
10/21/04